

REMARKS

The application contains claims 55-58, 61-63, 65-67, 69-71, 73-75 and 77-82.

Claim 56 is indicated above as being amended. However, this amendment is made to correct a typographical error in the claim that was made in the previous amendment.

In the above referenced office action, the Examiner rejected claims 55-58, 65-67, 69-71, 73-75 and 77-82 under 35 U.S.C. §103(a) as being unpatentable over Japanese patent 05-242721 in view of Ray et al.

Applicants have amended claim 55 to include the limitations of claims 57 and 58 in the alternative. This amendment was made necessary by the recent receipt of a copy of ZA 85/9359 which is an English language version of EP 0 184 714.

Accompanying this amendment is a copy of ZA 85/9359 and also a partial exact translation of JP 05-242721 (also previously cited by applicants) which is the primary reference used by the Examiner in rejecting the claims.

EP 0 184 714 (ZA 85/9359) has become relevant with the realization that the particles defined therein include iron particles as well as iron oxide particles as indicated in the abstract. Since claim 55 claimed only that the toner contained metal, this makes the reference material. Thus, the amendment to claim 55 was not made earlier, since applicants were not aware that such amendment was necessary. No new issues are raised by this amendment since the claim set already includes the new limitation of claim 55.

As to the additional translation of JP 05-242721, the Examiner has been relying on the machine translation of the reference in rejecting the claims. Since the JP machine translations are admittedly inaccurate and often impossible to understand, applicants requested that a Japanese associate translate relevant paragraphs (including this cited by the Examiner) of the reference.

With the additional partial translation of the JP reference in hand, applicants submit that the combination made by the Examiner is not *prima facie* obvious.

The Japanese reference teaches the use of a chargeable powder (toner) for use in producing printed circuits. (Paragraph [008]) The size of the *metal* particles defined in this reference is 0.5 microns. (Paragraph [0013]) As clearly stated in the object of the invention, the JP application is meant to solve the problems of uneven distribution of metal particles in the toner. (Paragraph [0005]) This uneven distribution causes breaks in the wiring pattern of the printed circuit (Paragraph [0007]) The use of fine metal particles is indicated in paragraph [0008] as solving this uneven distribution problem.

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The Examiner suggests in the rejection that it would have been obvious to use the much larger flakes of the Ray reference in the toner of the JP reference. Applicants submit, however, that this combination, as indicated by the Examiner, is not *prima facie* obvious for two reasons. First, it goes against the clear teaching of the JP reference that small powder material is to be used, in order to assure good distribution. Second, it would defeat the entire purpose of the JP reference, which is to foster even distribution. Third, there is no reason given or understood for providing larger flakes in the JP reference, since the JP reference deals with printed circuit boards, for which there is no need for the visual effect that would come from larger flakes.

Furthermore, the Ray reference teaches the use of a coating process for the large metal flakes, since as clearly stated at col. 7, lines 40-50, the use of normal processes of manufacture of the particles including the extrusion process and high shear mixing result in crushing of the metal flakes. It is noted that in the JP reference the smaller metal particles are dispersed in the polymer under pressure (paragraph [0015]) and then crushed in a cutter mill and a jet mill (paragraph [0016]). Thus, based on the similarity (with respect to the friability of the metal flakes) of the method used in the JP reference to those specifically indicated as being unsuitable in the Ray reference, there would not be an expectation that the JP method would result in the toner of the invention, even if there were some motivation for trying the combination proposed by the Examiner.

Thus, the combination has many of the indicators provided in MPEP §2143.01 and §2143.02 for a lack of *prima facie* obviousness. There is no motivation in combining the references as suggested by the Examiner, the proposed modification would render the primary prior art unsatisfactory for its purpose, the proposed modification would change the principle of operation of the primary reference and there would not be a reasonable expectation of success, since the resulting toner would not be suitable for the purpose intended.

For the sake of good order a PTO-1449 form listing the attached submissions is submitted herewith, together with a statement that the information submitted came into applicants' possession during the last three months. Applicants submit that since the submissions are either partial translations or corresponding applications in English of previously submitted references no additional fee should be required. However, if the Examiner disagrees, then the Examiner is authorized to charge our account 03-3419. If the Examiner makes such charge, he is respectfully requested to inform applicants in the next action (advisory or otherwise).

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Applicants submit that the present claims are patentable over the cited art. Applicants note that a Notice of Appeal has been filed in the present application and that the next date for filing the appeal brief is in mid September. A notice of allowance or an advisory action is respectfully requested to allow the applicants to prepare the brief.

Respectfully submitted,
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